

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Rhonan Ford et al.	Art Unit	: 1625
Serial No.	: 10/566,320	Examiner	: Nizal S. Chandrakumar
Filed	: January 26, 2006	Conf. No.	: 3505
Title	: QUINOLINE DERIVATES AND THEIR USE IN THERAPY		

**Mail Stop Amendment**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

This paper is responsive to a Restriction Requirement having a mail date of February 25, 2008 ("the RR").

**I. Status of the Claims**

On page 2 of the RR, the Office states: "[c]laims 15-19 are not considered because the claims contain the non-statutory terminology 'use of'."

However, the present application was filed a Preliminary Amendment, which instructed the Office *inter alia* to (i) cancel claims 16 and 17; (ii) amend claims 15, 18, and 19; and (iii) add new claim 22. More specifically, claims 15, 18, and 19 in their presently amended form are reproduced below:

15. A method of treating rheumatoid arthritis, the method comprising administering to a patient a therapeutically effective amount of a compound of formula (I) or a pharmaceutically acceptable salt or solvate thereof as claimed in claim 1.

18. A method of treating osteoarthritis, the method comprising administering to a patient a therapeutically effective amount of a compound of formula (I) or a pharmaceutically acceptable salt or solvate thereof as claimed in claim 1.

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

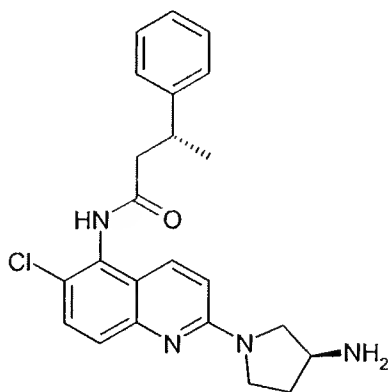
I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: April 25, 2008

19. A method of treating atherosclerosis, the method comprising administering to a patient a therapeutically effective amount of a compound of formula (I) or a pharmaceutically acceptable salt or solvate thereof as claimed in claim 1.

As such, it would appear that the Office's ground for not considering claims 15, 18, and 19 no longer applies to claims 15, 18, and 19 in their presently amended form, and Applicants respectfully request that claims 15, 18, and 19 be considered in concert with the remaining pending claims, including claim 22, which recites:

22. (New) The method of claim 21, wherein the obstructive airways disease is asthma or chronic obstructive pulmonary disease.

II. In response to the RR, Applicants elect Group 1, claims 1-8, 11, 12, and 14 "drawn to compounds" (RR, page 2). Commensurate with the election of Group 1, applicants elect, for initial search purposes only, the species compound, (βR)-N-[2-[(3S)-3-Amino-1-pyrrolidinyl]-6-chloro-5-quinolinyl]-β-methyl-benzenepropanamide, which is the title compound of Example 13 and is delineated in the Specification, e.g., at page 49, line 14 through page 50, line 12. The structure of the aforementioned compound is provided below:



Here, p is 1; R<sup>1</sup> is Cl; X is NHC(O); n is 2; R<sup>5</sup> and R<sup>6</sup> on the CR<sup>5</sup>R<sup>6</sup> closest to the carbonyl are both H; R<sup>5</sup> and R<sup>6</sup> on the CR<sup>5</sup>R<sup>6</sup> closest to the phenyl ring are H and methyl; R<sup>2</sup> is

phenyl;  $R^3$  is  $-NR^7R^8$  in which the  $-NR^7R^8$  group forms a pyrrolidine ring which is substituted by  $-NH_2$ . This species is readable on claims 1-4, 6-9, 12, 13, 15, and 18-22.

This election is made with traverse, which is discussed in more detail below.

**III.** Applicants respectfully request that the subject matter of claims 9, 13, 15 and 18-22 (method of making and method of treatment claims) be rejoined and examined in concert with the compound and pharmaceutical composition claims for at least the following reason. The present application is a U.S. National Stage application. As such, **the present application is subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499 (see MPEP § 1896)**. Each of claims 9, 13, 15 and 18-22 share a special technical feature, which is also the same special technical feature required by claim 1 (the compounds of formula (I) as presently claimed). In addition, 37 CFR § 1.475(b)(3) states that a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to a combination of "a product, a process specially adapted for the manufacture of the said product, and a use of the said product," which is the case with claims 1-8, 11, 12, and 14 and 9, 13, 15 and 18-22.

Applicants note that the Office **must** follow PCT Rule 13 and not national practice in these determinations. Thus, even if the Groups were properly restricted under national practice (and Applicants do not concede that to be the case), PCT Rule 13 requires, in this case, rejoinder of the Groups. Thus, all claims, regardless of whether they are compound, pharmaceutical composition, or method of using or making, possess unity in the present case and should be examined in the present application.

Applicant : Rhonan Ford et al.  
Serial No. : 10/566,320  
Filed : January 26, 2006  
Page : 4 of 4

Attorney's Docket No.: 06275-490US1 / 101140-1P US

CONCLUSION

Applicants encourage the Examiner to contact the undersigned should the Examiner wish to discuss the restriction groups, this election, or a proposed search strategy. Applicants thank the Examiner in advance for this courtesy.

Please apply any charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 06275-490US1 / 101140-1P US.

Respectfully submitted,

Date: April 25, 2008

/John T. Kendall/  
John T. Kendall, Ph.D.  
Reg. No. 50,680

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906